

REMARKS

Summary

Claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38 stand in this application. Claims 2, 5, 8, 12, 15, 17, and 39 have been canceled without prejudice. Claims 1, 4, 6, 7, 10, 11, 13, 14, 16, 18, 29, 32, and 38 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

35 U.S.C. § 103

At page 3, paragraph 4 claims 1, 3, 4, 6, 7, 9-11, 18, 19, 21-25, 27, 29, 30, 31, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 6,631,141 to Kumar et al. ("Kumar") in view of US 5,959,968 to Chin et al. ("Chin"). At page 10, paragraph 5 claims 2, 5, 8, 12, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Chin and further in view of US 2004/0068686 to Palm ("Palm"). At page 12, paragraph 6 claims 13, 14, 16, 20, 26, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Chin and US 7,308,612 to Bishara ("Bishara"). At page 16, paragraph 7 claims 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Chin and Bishara and further in view of Palm. At page 17, paragraph 8 claims 32-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Palm and Chin. Applicant respectfully traverses the rejections, and requests reconsideration and withdrawal of the obviousness rejections.

Applicant has cancelled claims 2, 5, 8, 12, 15, 17, and 39 and has incorporated their subject matter into claims 1, 4, 6, 10, 13, 16, and 38, respectively. Therefore, the obviousness rejections with respect to claims 2, 5, 8, 12, 15, 17, and 39 will be addressed below with respect to the amended claims.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38. Therefore claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38 define over the cited references whether taken alone or in combination. For example, claim 1 recites the following language, incorporated in part from claim 2, in relevant part:

sending a first message including an aggregation discovery code from a first node to a second node, the second node including a remote discovery register, wherein the first message comprises a capabilities list+request (CLR) message;

receiving a second message at the first node, the second message including the contents of the second node's remote discovery register, the contents of the remote discovery register indicating whether a PHY of the second node has been allocated for aggregation, wherein the second message comprises a capabilities list+request (CLR) message;

As correctly noted in the Office Action, the above-recited language is not disclosed by Kumar or Chin. According to the Office Action, the missing language is disclosed by Palm at paragraph 104 lines 1-6 and paragraph 106 lines 1-3. Applicant respectfully disagrees.

Applicant respectfully submits that Palm fails to disclose the missing language of the claimed subject matter. For example, Palm at the given cite, in relevant part, teaches responding to a request with one of an acceptance, rejection, or a desire to initiate a different type of message. By way of contrast, the claimed subject matter discloses responding to a request with the contents of a register. Therefore, Palm fails to disclose, teach or suggest the missing language. Consequently, the cited references, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1.

For at least these reasons, Applicant submits that claim 1 is patentable over the cited references, whether taken alone or in combination. In addition, claims 4, 6, 10, 13, 16, 18, 29, 32, and 38 recite features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claims 4, 6, 10, 13, 16, 18, 29, 32, and 38 are not

obvious and are patentable over the cited references for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 1, 4, 6, 10, 13, 16, 18, 29, 32, and 38. Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claims 3, 7, 9, 11, 14, 19-28, 30, 31, and 33-38 that depend from claims 1, 4, 6, 10, 13, 16, 18, 29, 32, and 38, and therefore contain additional features that further distinguish these claims from the cited references.

Furthermore, Applicant submits that even if the combination of the cited references were to teach or suggest every element of the claimed invention, without motivation to combine the cited references to arrive at the claimed invention, a rejection based on obviousness under 35 U.S.C. § 103(a) is improper. *See* MPEP § 2143.01, for example. The motivation to make the alleged combination must be found either in the cited references or in the knowledge generally available to a person of ordinary skill in the art. *Supra*. Possible sources for a motivation to combine references include: (1) the nature of the problem to be solved; (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. The Office, however, cannot rely solely upon the level of skill in the art to provide the suggestion to make the alleged combination of cited references. *Supra*. Initially, the burden is on the Office to provide some suggestion that it is desirable to do what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner

must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *See MPEP § 2142*, for example.

Claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38 also are patentable and non-obvious over the cited references, whether taken alone or in combination, because a rejection based on obviousness under 35 U.S.C. § 103(a) is improper without a motivation to combine the cited references. *See MPEP § 2142*, for example. For example, with respect to claim 1, Kumar and Chin fail to discuss exchanging link aggregation data during handshaking. Therefore, Kumar and Chin clearly fail to provide the proper motivation to make the combination alleged by the Office. Similarly, Palm also fails to provide the proper motivation to combine. The Office presents as a motivation that to do so is “to make the system more efficient by determining the capabilities of the nodes during the setup of the connection.” Applicant respectfully submits, however, that the CL and CLR message exchange is described in Palm as an “xDSL startup method,” as stated in paragraph 0074. Applicant respectfully submits that Palm discloses a motivation to use CL and CLR message exchange to disclose capabilities of the equipment or link used during the setup. Applicant respectfully submits that this is different than using CL and CLR message exchange to disclose the existence of other links entirely. Applicant respectfully submits that Palm discloses a motivation to use CL and CLR message exchange to perform startup of a link. Applicant respectfully submits that this is different than using CL and CLR message exchange to modify the use of another link.

For at least the reasons given above, claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38 is respectfully requested.

Conclusion

For at least the above reasons, Applicant submits that claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

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Response Dated September 30, 2008
Reply to Office Action of May 30, 2008

Docket No.: 1020.P16568
Examiner: Betty E. Lee
TC/A.U. 2619

It is believed that claims 1, 3, 4, 6, 7, 9-11, 13, 14, 16, and 18-38 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-9338 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account 50-4238.

Respectfully submitted,

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John F. Kacvinsky, Reg. No. 40,040
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